

Patent  
Atty. Dkt. No. 016912-0209  
Application No. 10/507,501  
Response to Office action dated October 6, 2006

**REMARKS**

Applicant respectfully requests reconsideration of the present application.

**I. Disposition of the claims**

Claims 1-7 and 9-20 are pending and stand rejected.

**II. Amendments to the claims**

Claim 1 is currently amended.

In Claim 1, the oil-soluble resin in component (C) now recites one or more members selected from the group consisting of perfluoroalkyl group-containing polyalkylsiloxy silicate. The basis of this amendment can be found in Original Claim 8, which has been canceled without prejudice or disclaimer. No new matter has been added.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate status identifier.

**III. Comments on the Official Action**

This comment particularly concerns the claim rejections based on 35 U.S.C. § 103(a). Please note that the international filing date of the present application was March 11, 2002, which was before the publication date (March 18, 2003) of Wada (US 6534044). However, the corresponding International publication of Wada was published on July 20, 2000 (WO 00/042112) in Japanese. It is submitted that WO 00/042112 should be cited and that Wada (US 6534044) should be treated as a translation thereof.

**IV. Rejection under 35 U.S.C. § 103(a)**

Claims 1, 3-10, 12, and 14-20 are rejected as obvious over Ichinohe (WO 02/03928, translated by U.S. Apn. Pub. No. 2003/0082218) in view of Yonekura (U.S. Pat. No. 4,892,726) and Wada (WO 00/042112, translated by U.S. Pat. No. 6,534,044). Office action, p. 3 (see p. 7, l. 9 for claims 17-20). According to the rejection, Ichinohe fails to “teach the use of polymethylsilsesquioxane as a component in [a] cosmetic composition [and fails to teach to] selectively use polymethylsilsesquioxane as a component of the composition of example 11.” Office action, p. 4. To remedy these deficiencies, the rejection uses the teachings of Yonekura, which, according to the rejection, include “the use of polymethylsilsesquioxane powders as a component of ... cosmetic compositions.” Office action, p. 4. In conclusion, the rejection reasoned that it “would have been obvious ... to incorporate the ... polymethylsilsesquioxane into the cosmetic composition because Ichinohe ... teaches the use of polymethylsilsesquioxane ... and Yonekura ... teaches the use of polymethylsilsesquioxane in a cosmetic.” Office action, p. 4. The rejection further applies Wada, Office action, p. 5, for reasons not relevant to traverse the rejection.

According to the present version of the claims, the present cosmetic composition contains perfluoroalkyl group-containing polyalkylsiloxy silicate (component (C)). Applicants respectfully submit that the present specification contains the following statement: “among the above-described examples, perfluoroalkyl group-containing polyalkylsiloxy silicate is particularly effective for the cosmetic composition of the present cosmetic composition. When compared with trimethylsiloxy silicate of the same mass ratio, perfluoroalkyl group-containing polyalkylsiloxy silicate was recognized to have about twice as effective as trimethylsiloxy silicate in imparting water-runability.” The present specification, page 12, lines 3 to 10.

On the other hand, the composition in Example 11 of Ichinohe contains trimethylsiloxy silicate, but does not contain a perfluoroalkyl group-containing

polyalkylsiloxysilicate. Furthermore, Ichinohe contains no statement about a perfluoroalkyl group-containing polyalkylsiloxysilicate. Neither Yonekura nor Wada discloses a perfluoroalkyl group-containing polyalkylsiloxysilicate.

Since silence cannot amount to the required motivation to establish a *prima facie* case of obviousness, the present cosmetic composition is not obvious over Ichinohe in view of Yonekura and Wada. Thus, the rejection should be withdrawn.

Moreover, the Examiner has urged that component (B) is easily derived from Ichinohe and Yonekura (line 9 from the bottom of page 3 to line 8 of page 5, Official Action). As the Examiner mentioned in the Official Action, polymethyl silsesquioxanes are disclosed in Ichinohe. However, they are exemplified for powders and/or coloring agents among various inorganic and organic powders (paragraphs 30, 31 and 33, Ichinohe), and the amount for such powders and/or coloring agents disclosed is extremely broad (0.1 to 99 weight %, paragraph 38, Ichinohe). Polymethyl silsesquioxanes are also disclosed in Yonekura et al. However, the amount thereof disclosed is extremely broad (0.1 to 60 weight % or 0.1 to 40 weight %, lines 45 to 53 of column 2, Yonekura).

On the other hand, the present cosmetic composition comprises component (B) in specific amount (0.2 to 5 weight %). It is clear from the comparison between the effects of Example 1 to those of Comparative Examples 3 and 4, to formulate component (B) in an amount of 0.2 to 5 weight % is used for the present cosmetic composition.

Furthermore, Ichinohe does not pay attention to using components (A) to (E) in specific amounts. For example, various non-volatile oil agents and various volatile solvents (overlapping with Component (A)) are exemplified in parallel for unctuous agent (overlapping with Component (D)) used together with silicone-modified wax in Ichinohe (paragraphs 17 to 22)). The Amount for unctuous agent disclosed in Ichinohe is extremely broad (1 to 98 weight %,

paragraph 23). Further, some compounds exemplified for a compound having at least one alcoholic hydroxyl in its molecular structure in Ichinohe correspond to volatile solvents (paragraphs 25 and 26). Without anything but overbroad statements, it is impossible to arrive at Component (A) or (D) in a specific amount from Ichinohe. Thus, for this reason too, the rejection should be withdrawn.

Claim 2 is rejected as obvious over Ichinohe as applied in the first rejection and further in view of Fukuchi (English Translation of JP 01211518). Office action, pp. 8-9. The rejection does not use Fukuchi to remedy the deficiencies of Ichinohe that were noted above. Thus, this rejection should be withdrawn too.

Claims 11 and 13 are rejected as obvious over Ichinohe as applied in the first rejection and further in view of Hayashi (English Translation of JP 2000327948). Office action, pp. 9-10. The rejection does not use Hayashi to remedy the deficiencies of Ichinohe that were noted above. Thus, this rejection should be withdrawn too.

### Conclusion

The present application is believed to be in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Patent  
Atty. Dkt. No. 016912-0209  
Application No. 10/507,501  
Response to Office action dated October 6, 2006

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 02-06-2007

FOLEY & LARDNER LLP  
Customer Number: 22428  
Telephone: (202) 672-5414  
Facsimile: (202) 672-5399

By Richard L. Schwaab (45943)  
Sean A. Passino FOR  
Richard L. Schwaab  
Attorney for Applicant  
Registration No. 25,479